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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,146	09/26/2005	Scott Murphy	584542000200	9164
25227 7590 10/14/2010 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
ATALA, JAMIE JO				
ART UNIT		PAPER NUMBER		
2484				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,146

Applicant(s)

MURPHY, SCOTT

Examiner

JAMIE ATALA

Art Unit

2484

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/26/10.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 26, 2010 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 and 23 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter the claims have improper language regarding the computer readable medium (Please see the MPEP 2106 Section IV. Determine Whether the Claimed Invention Complies with 35 U.S.C. 101). The claims fail to disclose what executes the instructions for performing the operations. The examiner suggests changing the preamble to a computer-readable medium encoded with (stored thereon, embedded with or embodying) a computer program, causing the computer the execute: "Linking words such as including, comprising, listing and having, are not acceptable as a substitute term for "encoded with". .

Response to Arguments

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. Furthermore, regarding applicants arguments found on pages 5-6 regarding receiving a user request for a digital file and supplying the requested file from the data bank to the remote client server is clearly recited by Tsukamoto et al. As described in paragraphs 0130-0134 the information is registered and requested by the user and further sent to the user for further processing. Additionally, as seen in Figure 4 recording element 15 the user has the ability to record the information that has been requested as further described in paragraphs 0023. Although, applicants points are understood the examiner can not agree on these points regarding the Tsukamoto et al reference. Additionally, to further teach the newly amended claim 1 regarding "digital files being from a remote client terminal via a communication network" newly applied reference Allen (US 5,909,638) is being used to teach the limitations. Furthermore, applicant argues that communication network is not accessible by a customer; however, Tsukamoto et al shows the use of customer input in Figures 4 and 5. Although, all of applicants points are understood the examiner can not agree.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-14, 20 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable by Tsukamoto et al (US 2002/0013940) in view of Allen (US 5,909,638).
[claim 1]

In regard to Claim 1, Tsukamoto et al discloses a method for supplying digital files to the customer via a data communications network, comprising

- providing a recordable medium to a customer (Figures 4 and 5 shows the recording device);
- registering details of the customer and the recordable medium in a data bank (Paragraphs 130-134 describes the information needed in order to register and provide download of content);
- receiving a customer request to supply one or more digital files (Paragraph 134 describes the user wanting to get content from the system);
- authenticating the recordable medium and the identity of the customer (Paragraphs 0129-0135 describes the authenticating of the data), and
- if authentication is successful, supplying the requested one or more digital files from the data bank to a client terminal via the data communications network for record on the recordable medium, wherein the client terminal is configured to record the one or more digital files (Paragraphs 0134-0140 describes the successful transmission of data to the user. Furthermore, paragraph 0023 describes the user ability to record data as further seen in Figure 4 recording element 15); however, fails to disclose

- receiving a customer request to supply one or more digital files from a remote client terminal associated with the customer via the data communication network.

Allen teaches a system for video distributing (Figure 1) further comprising:

- receiving a customer request to supply one or more digital files from a remote client terminal associated with the customer via the data communication network (Column 5 Lines 33-67 describes the user selected files and furthermore as described in Column 21 Lines 15-67 through Column 22 Lines 1-67).

Thereby the system as taught by Allen allows for the system to receive digital files both locally (in the store) or at home via a communication network to provide real-time processing of the customers request (Column 3 Lines 30-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the remote recording system, as disclosed by Tsukamoto et al, and further incorporate a system that allows for a remote client terminal via a data communication network, as taught by Allen, in order to allow for efficient and more effective processing of the customer request across the network.

[claim 4]

In regard to Claim 4, Tsukamoto et al discloses a method wherein the digital files are music files or other video, audio or data content (paragraphs 0085-0089).

[claim 5]

In regard to Claim 5, Tsukamoto et al discloses a method according wherein the recordable medium supplied to the customer includes one or more pre-recorded digital files (Paragraphs 0085-0089 describes the content sent to the user wherein the data is rented movies that are pre-recorded).

[claim 6]

In regard to Claim 6, Tsukamoto et al discloses a method according wherein the recordable medium includes a recordable medium identifier (paragraphs 0130-0135 describes the identifier used for identifying content to the recording medium).

[claim 7]

In regard to Claim 7, Tsukamoto et al discloses a method according to comprising: registering the recordable medium identifier and the customer details in the data bank in step, and detecting the recordable medium identifier from the recordable medium (Paragraphs 0130-0134 describes the registering of user and system data).

[claim 8]

In regard to Claim 8, Tsukamoto et al discloses a method according to any wherein the customer details include a customer name and password (Paragraph 0080).

[claim 9]

In regard to Claim 9, Tsukamoto et al discloses a method wherein step includes: receiving customer entered validation data, and comparing the validation data to the customer name and password stored in the data bank (Paragraphs 0130-0134).

[claim 10]

In regard to Claim 10, Tsukamoto et al discloses a method wherein the data bank is maintained by a predetermined content supplier (Paragraphs 0125-0140 describes the content supplier).

[claim 11]

In regard to Claim 11, Tsukamoto et al discloses a method further comprising: receiving the customer request an intermediary server; identifying the predetermined content supplier, and directing the customer request to the data bank of that predetermined content supplier (Paragraphs 0125-0140 describes the content data being processed).

[claim 12]

In regard to Claim 12, Tsukamoto et al discloses a method wherein the recordable medium includes a content supplier identifier (Paragraphs 0125-0140 describes the content supplier).

[claim 13]

In regard to Claim 13, Tsukamoto et al discloses a method comprising: identifying the predetermined content supplier by detecting the content supplier identifier at the intermediary server (Paragraphs 0125-00140).

[claim 14]

In regard to Claim 14, Tsukamoto et al discloses a method comprising: issuing the manufacturer and retailer with unique identifying codes (Paragraph 0080-0090 describes the unique identifiers associated with the system).

[claim 20]

In regard to Claim 20, Tsukamoto et al discloses a method comprising:
providing the customer with notification of one or more digital files able to be supplied
from the data bank (Paragraphs 0080-0100 describes notifying the user).

[claim 23]

In regard to Claim 23, Tsukamoto et al discloses a computer software stored on a
readable medium_for use with a content server forming part of the system for supplying
digital files to a customer via a data communications network, the content server
including a processing unit and associated memory device for storing the computer
software, wherein the computer software acts to cause the content server to carry out a
method (Paragraphs 0130-0134 describes the content being delivered as seen in Figure
4).

4. Claims 2 and 3 rejected under 35 U.S.C. 103(a) as being unpatentable over
Tsukamoto et al (US 2002/0013940) in view of Allen (US 5,909,638).

[claim 2]

In regard to Claim 2, Tsukamoto et al discloses a method wherein the recordable
medium is a recordable DVD (Figure 5 shows the recording medium to be a HDD and
also a set top box. It is well known that set top box and HDD can also contain optical
storage medium and thereby the examiner takes official notice that the recording
medium could include recordable DVD in order to allow various recording mediums to
be interchanged within the system).

[claim 3]

In regard to Claim 3, Tsukamoto et al discloses a method wherein the recordable DVD is connected to the client terminal by a recordable DVD drive (Figure 5 shows the recording medium to be a HDD and also a set top box. It is well known that set top box and HDD can also contain optical storage medium and thereby the examiner takes official notice that the recording medium could include recordable DVD).

5. Claims 15-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al (US 2002/0013940) in view of Allen (US 5,909,638) in view of Simmons (US 2002/0112172).

[claim 15]

In regard to Claim 15, Tsukamoto et al in view of Allen discloses a method comprising processing information for the customer (Paragraphs 0080-0090 describes the customer detailed information); however, fails to disclose the data being processed is customer payment for the one or more digital files. Simmons teaches a system for processing payment information as described in paragraphs 0002-0015. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to use the customer database system, as taught by Tsukamoto et al in view of Allen, and further incorporate a system that provide payment data, in order to provide an effective and secure method for payments.

[claim 16]

In regard to Claim 16, Simmons disclose a method wherein the customer payment is processed when the recordable medium is provided to the customer (Paragraphs 0002-0015 describe customer information).

[claim 17]

In regard to Claim 17, Tsukamoto et al discloses a method wherein the customer payment relates to the pre-recorded digital files only (Paragraphs 0002-0015 describe customer information).

[claim 18]

In regard to Claim 18, Tsukamoto et al discloses a method wherein the customer payment relates to the pre-recorded digital files and one or more digital files (Paragraphs 0002-0015 describe customer information).

[claim 19]

In regard to Claim 19, Tsukamoto et al discloses a method wherein the customer payment processed when a customer request (Paragraphs 0002-0015 describe customer information).

[claim 23]

In regard to Claim 23, the claim limitations have been disclosed in Claim 1.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE ATALA whose telephone number is (571)272-7384. The examiner can normally be reached on Monday - Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMIE ATALA/
Primary Examiner, Art Unit 2484